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REMARKS

Claims 10, 39-45 are currently pending in the subject application and are presently under consideration. Claims 40 and 44 have been amended herein to address minor informalities.

It is noted that the Office Action does not state grounds for rejecting claims 10 and 45 – applicants' representative requests that the Examiner provide an indication that such claims are allowed or in the alternative a basis for rejection thereof.

Additionally, the Office Action incorrectly identifies the Gorog reference as US Patent No. 5,640,002. Applicants' representative has responded to this Office Action *via* considering Gorog (US Patent No. 4,947,028).

Favorable reconsideration of the subject patent application is respectfully requested in view of the comments and amendments herein.

I. Objection To Claim 40

Claim 40 has been objected to because of a spelling error. Applicants' representative thanks the Examiner for pointing out this error and hereby amends the claim by changing the word "are" to "area". Accordingly, withdrawal of this objection is respectfully requested.

II. Rejection of Claims 39-44 Under 35 U.S.C. §103(a)

Claims 39-44 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Ross *et al.* in view of Gorog. Withdrawal of this rejection is respectfully requested for at least the following reasons. Neither Ross *et al.* nor Gorog, alone or in combination, teach or suggest applicants' claimed invention let alone there being no motivation to combine the references as suggested other than *via* employment of applicants' specification as a 20/20 hindsight-based roadmap to achieve the purported combination.

To reject claims in an application under §103, an examiner must establish a *prima facie* case of obviousness. A *prima facie* case of obviousness is established by a showing of three basic criteria. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skilled in the art, to

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modify the reference or to combine reference teachings. Second there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) *must teach or suggest all the claim limitations*. See MPEP §706.02(j). The *teaching or suggestion to make the claimed combination* and the reasonable expectation of success *must be found in the prior art and not based on the Applicant's disclosure*. See *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). An examiner cannot establish obviousness by locating references which describe various aspects of a patent applicant's invention without also providing evidence of the motivating force which would impel one skilled in the art to do what the patent applicant has done." *Ex parte Levengood*, 28 U.S.P.Q.2d 1300 (P.T.O.B.A.&I. 1993).

Independent claim 39 in part recites features directed to fulfilling an order. However, the suggested combination of references in the Office Action merely addresses an aspect of placing of an order. Specifically, one feature of the claimed invention is retrieving, through a portable terminal located on a vehicle, the placed orders from a central order processor for delivery to a client. Independent claim 39 recites ***a portable terminal having a data communication network connection for retrieving an order from a central order processor; and a vehicle cradle for mounting on a motorized delivery vehicle for delivering goods to a customer destination location***. This is not disclosed in the purported combination.

Rather, the suggested combination, merely addresses a mobile system for placing orders. Ross *et al.* is directed to a personal onboard information system for use in a vehicle. The system includes a portable personal computer and a cradle mounted on the vehicle for detachably receiving the computer. Gorog, as a whole is directed to an automated order and payment system for use by consumers to place orders, (and pay), for products and services from any location at which the consumer is present at the time of ordering. Combining these references by placing Gorog's automated order and payment system on board the information system of Ross *et al.*, will result in a system of placing orders that is mounted on a vehicle. As such, the proposed combination would result in a system for still placing orders rather than *retrieving orders* for fulfillment thereof as in applicants' claimed invention. Moreover, the cited references do not teach or suggest ***a portable terminal having a data communication network connection for retrieving the***

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order from the central order processor for delivery to a customer as in the claimed invention.

Since Gorog already permits customers to order at any location, any extra mobility feature obtained by employing the vehicle system of Ross *et al.* would be redundant and thus, an irrational impetus for combining such references. Accordingly, there is no motivation to combine Ross *et al.* and Gorog. The Office Action further purports to support the proposed combination by stating; "such combined system would allow users to conveniently plan their activities and effectively shop for their needs [...] would provide much greater flexibility and convenience wherein individuals could fulfill their purchase order for travel items while traveling to their destination [...] Therefore, it would have been an obvious expedient well within an ordinary skill in the art."

Regarding the combination of references, applicants' representative respectfully submits that the rationale proffered to combine such teachings is to achieve benefits identified in applicants' specification. It is respectfully submitted that this is an unacceptable and improper basis for a rejection under 35 U.S.C. §103. In essence, the Examiner is basing the rejection on the assertion that it would have been obvious to do something not suggested in the art because so doing would provide advantages stated in applicants' specification. This sort of rationale has been condemned by the CAFC; *See e.g., Panduit Corp. v. Dennison Manufacturing Co.*, 1 USPQ2d 1593 (Fed. Cir. 1987).

In view of at least the above, it is readily apparent that the combination of references does not teach or suggest applicants' claimed invention, and therefore should be withdrawn.

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III. Conclusion

The present application is believed to be in condition for allowance in view of the above amendments and comments. A prompt action to such end is earnestly solicited.

In the event any fees are due in connection with this document, the Commissioner is authorized to charge those fees to Deposit Account No. 50-1063.

Should the Examiner believe a telephone interview would be helpful to expedite favorable prosecution, the Examiner is invited to contact applicants' undersigned representative at the telephone number listed below.

Respectfully submitted,

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